

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 46

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NKOLE E. TAYALI and ALAN R. SHIRET

Appeal No. 2000-2230
Application No. 08/706,767

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, STAAB and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 15 to 34, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to thermosyphon radiators (specification, p. 1). A copy of the claims 16 to 24 and 26 to 34 under appeal is set forth in the appendix to the appellants' brief. Claims 15 and 25, which were not correctly set forth in the appendix to the appellants' brief, read as follows:

15. A thermosyphon radiator comprising a sealed panel containing a reservoir of vaporizing liquid in a lowermost part of the panel and a pipe extending through the vaporizing liquid and extending through only the lowermost part of the panel with clearance, said lowermost part having first and second opposed ends and said pipe entering the first end and exiting through the second, opposed end, the pipe being coated externally with a coating comprising a metallic coating without a downwardly depending wick, said metallic coating being selected from the group consisting of a fine metallic mesh, and a compacted metal wool.

25. A thermosyphon radiator comprising a sealed panel containing a reservoir of vaporizing liquid in a lowermost part of the panel and a pipe extending through the vaporizing liquid and extending only through the lowermost part of the panel with clearance, said lowermost part having first and second opposed ends and said pipe entering the first end and exiting through the second, opposed end, the pipe being coated externally with a coating without a downwardly depending wick, said coating comprising a ceramic porous material.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Berger et al. 1984 (Berger)	4,452,051	June 5,
Grover et al. 1987 (Grover)	4,640,347	Feb. 3,
Seidenberg et al. 1989 (Seidenberg)	4,883,116	Nov. 28,
Tanaka et al. 1977 (Tanaka)	JP 52-74949 ¹	June 23,
Scurrah	GB 2 099 980 A	Dec. 15, 1982
Fukushima et al. (Fukushima)	JP 64-42341 ²	Feb. 14, 1989

Claims 15 to 34 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

¹ In determining the teachings of Tanaka, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellants' convenience.

² In determining the teachings of Fukushima, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellant's convenience.

Claims 15 to 34 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellants, at the time the application was filed, had possession of the claimed invention.

Claims 15 to 19, 21 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Scurrah in view of Tanaka.

Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over Scurrah in view of Tanaka as applied above, and further in view of Berger.

Claims 23 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Scurrah in view of Tanaka as applied above, and further in view of Grover.

Claims 25 to 29, 31 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Scurrah in view of Tanaka as applied above, and further in view of Seidenberg or Fukushima.

Claim 30 stands rejected under 35 U.S.C. § 103 as being unpatentable over Scurrah in view of Tanaka and Seidenberg or Fukushima as applied above, and further in view of Berger.

Claims 33 and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Scurrah in view of Tanaka and Seidenberg or Fukushima as applied above, and further in view of Grover.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 37, mailed March 6, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 36, filed January 5, 2000) and reply brief (Paper No. 38, filed May 4, 2000) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We will not sustain the rejection of claims 15 to 34 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C.

§ 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

Furthermore, the appellants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 213-14, 169 USPQ 226, 228-29 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

With this as background, we analyze the specific rejection under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal. The examiner determined (answer, p. 3) that the recitation of the phrase "without a downwardly depending wick" in claims 15 and 25 was indefinite since the phrase has not been described in the specification in such full, clear, concise and exact terms.

We do not agree with the examiner's determination that the phrase "without a downwardly depending wick" in claims 15 and 25 is indefinite. In that regard, the scope of the phrase (i.e., the metes and bounds thereof) is clearly determinable with a reasonable degree of precision and particularity. Furthermore, while the exact phrase has not been described in the specification, the specification as a whole (see especially lines 1-2 of page 2) clearly teaches that the appellants' invention is a thermosyphon radiator which does not utilize a downwardly depending wick as was done in the prior art (see Figure 3 of Scurrah and the discussion thereof on page 1 of the appellants' specification).

For the reasons set forth above, the decision of the examiner to reject claims 15 to 34 under 35 U.S.C. § 112, second paragraph, is reversed.

The written description rejection

We sustain the rejection of claims 15 to 24 under 35 U.S.C. § 112, first paragraph, but not the rejection of claims 25 to 34.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The examiner determined (answer, p. 3) regarding claims 15 and 25 that "the originally filed specification fails to disclose the pipe being coated with a metallic, non downwardly depending wick coating selected from the group consisting of a fine metallic mesh and a compacted metal wool."

We will not sustain this rejection as it pertains to claims 25 to 34 since the objected to language is not found in claim 25.

We sustain this rejection as it pertains to claims 15 to 24 since the original disclosure does not provide written description support for the use of the words "coated" and "coating" in the phrase "the pipe being coated externally with a coating comprising a metallic coating without a downwardly depending wick, said metallic coating being selected from the group consisting of a fine metallic mesh, and a compacted metal wool." As pointed out by the examiner (answer, p. 8), the original disclosure (at page 2) provides that the pipe is covered, not coated, externally with a fine metallic mesh, and a compacted metal wool. In contrast, the original disclosure (at page 2) did provide that the pipe can be coated with a

porous material such as sintered metallic or ceramic material. In the reply brief (p. 1), the appellants agree that the examiner is technically correct and offered to amend claim 15 by changing "coated" to --covered-- and by changing "coating" to --covering--. However, the examiner refused to enter these amendments.

The obviousness rejections

We will not sustain the rejection of claims 15 to 34 under 35 U.S.C. § 103.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And

"teachings of references can be combined only if there is some suggestion or incentive to do so." Id.

All the claims under appeal require the pipe which extends through the vaporizing liquid to be externally coated with either a ceramic porous material (claims 25 to 34) or either a fine metallic mesh or a compacted metal wool (claims 15 to 24). However, it is our view that these limitations are not suggested by the applied prior art. In that regard, while Scurrah does teach in Figures 1-2 a pipe 2 which extends through the vaporizing liquid 3, Scurrah does not teach or suggest using an external coating on that pipe. We see no motivation in the teachings of the applied prior art (e.g., Tanaka's metal pipe 11 externally covered with a spongy metal wire 12; Fukushima's ceramic coating; Seidenberg's ceramic heat pipe wick) to have provided Scurrah's pipe 2 which extends through the vaporizing liquid 3 with an external coating/covering as recited in the claims under appeal.

In our view, the only suggestion for modifying Scurrah in the manner proposed by the examiner to meet the above-noted

limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 15 to 34.

CONCLUSION

To summarize, the decision of the examiner to reject claims 15 to 34 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 15 to 24 under 35 U.S.C. § 112, first paragraph, is affirmed; the decision of the examiner to reject claims 25 to 34 under 35 U.S.C. § 112, first paragraph, is reversed; and the decision of the examiner to reject claims 15 to 34 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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LARSON & TAYLOR, PLC
TRANSPOTOMAC PLAZA
1199 NORTH FAIRFAX STREET
SUITE 900
ALEXANDRIA, VA 22314

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